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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,117	04/02/2001	Joseph L. Michels	TC00099	6862
22863	7590	11/05/2004	EXAMINER	
MOTOROLA, INC. CORPORATE LAW DEPARTMENT - #56-238 3102 NORTH 56TH STREET PHOENIX, AZ 85018			GOLD, AVI M	
			ART UNIT	PAPER NUMBER
			2157	

DATE MAILED: 11/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/823,117

Applicant(s)

MICHELS ET AL.

Examiner

Avi Gold

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

The amendment received on August 12, 2004 has been entered and fully considered.

Response to Amendment

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5 and 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Langseth et al., U.S. Patent No. 6,694,316, further in view of Small et al., U.S. Patent No. 5,642,203.

Langseth teaches the invention substantially as claimed including a system and method for a subject-based channel distribution of automatic, real-time delivery of personalized informational and transactional data (see abstract).

As to claims 1 and 2, Langseth teaches method of previewing content in a distributed communications system comprising:

receiving a plurality of categorized content at a remote communications node (col. 3, lines 12-58; Langseth discloses categorized information sent to subscribers via mobile phone);

evaluating each of the categorized content and previewing the categorized content (col. 4, lines 22-38; Langseth discloses a subscriber choosing personalization options based on what content they want).

Langseth fails to teach the limitation further including the assigning contextual audio content to each of the categorized content and previewing the categorized content utilizing the contextual audio content and mixing the contextual audio content with the categorized content.

However, Small teaches a user's ability to configure an infrastructure and as a result perform time and location based computing (see abstract). Small teaches the use of a contextual audio reminder (col. 10, lines 16-28).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Langseth in view of Small to mix contextual audio content with the categorized content to preview the categorized content. One would be motivated to do so because contextual audio would allow the user to know what content is available without looking at a display.

As to claims 3 and 4, Langseth teaches the method of claim 1.

Langseth teaches the method of claim 1, wherein the categorized content comprises sub-categorized content and previewing the sub-categorized content (col. 5,

lines 9-28; Langseth discloses different services within the finance channel that can be viewed).

Langseth fails to teach the limitation further including assigning the contextual audio content to each of the sub-categorized content and previewing the sub-categorized content utilizing the contextual audio content.

However, Small teaches the use of a contextual audio reminder (col. 10, lines 16-28).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Langseth in view of Small to assign contextual audio content to each of the sub-categorized. One would be motivated to do so because contextual audio would allow the user to preview what sub-categorized content is available without looking at a display.

As to claim 5, Langseth teaches the method of claim 1, wherein receiving the plurality of categorized content comprises receiving categorized textual content (col. 3, lines 12-34; Langseth discloses a finance channel called "Market Update").

Claims 8-12 do not teach or define any new limitations above claims 1-5 and therefore are rejected for similar reasons.

3. Claims 6, 7, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Langseth and Small further in view of Abbott, III et al., U.S. Patent No. 6,513,046.

Langseth teaches the invention substantially as claimed including a system and method for a subject-based channel distribution of automatic, real-time delivery of personalized informational and transactional data (see abstract).

As to claims 6 and 7, Langseth teaches the method of claim 1.

Langseth and Small fail to teach the limitation further including the contextual audio content being user-provided and user-defined.

However, Abbott teaches computer-based storing of information about a current state to facilitate later recall (see abstract). Abbott teaches the use of a recording from the user providing descriptive information (col. 2, lines 43-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Langseth and Small in view of Abbott to use a user-provided and user-defined contextual audio content. One would be motivated to do so because it would allow the user to configure the contextual audio to their preference.

Claims 13 and 14 do not teach or define any new limitations above claims 6 and 7 and therefore are rejected for similar reasons.

Response to Arguments

4. Applicant's arguments filed August 12, 2004 have been fully considered but they are not persuasive.

In response to the argument that Langseth et al. is only previewing the type of content: The limitation in question states that it is "previewing the categorized content utilizing the contextual audio content." Previewing the type of content is a method of previewing content. It does not state in the limitation that it is previewing actual categorized content, thus the rejection stands.

In response to the argument that Small et al. does not teach or suggest categorized content: The Examiner never stated that Small teaches or suggests categorized content. The office action states that Small teaches a contextual audio reminder that is used in a 103(a) rejection in conjunction with Langseth et al., which does teach categorized content.

5. In response to applicant's argument that Small et al. is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Small et al. is prior art involved in computing as is the prior art of Langseth et al.

6. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by

combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation used to combine is found in the prior art of Small et al (col. 10, lines 20-24).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 6,195,655 to Lawler.

U.S. Pat. No. 6,522,333 to Hatlelid et al.

U.S. Pat. No. 6,421,305 to Gioscia et al.

U.S. Pat. No. 6,526,355 to Treyz et al.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Avi Gold whose telephone number is 571-272-4002. The examiner can normally be reached on M-F 8:00-5:30 (1st Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Avi Gold
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